

Docket No. F-8167

Scr. No. 10/791,388

REMARKS

Claims 1, 2, 4, 5 and 11-26 are now pending in this application. Claims 1, 2, 4 and 5 are rejected. Claims 3 and 6-10 are cancelled herein. New claims 11-24 are added. Claims 1, 2, 4 and 5 are amended herein to clarify the invention, to broaden language as deemed appropriate and to address matters of form unrelated to substantive patentability issues.

CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1, 2, 4, and 5 are rejected as obvious over the Mooradian reference in view of the Zhang reference under 35 U.S.C. §103(a). The applicant herein respectfully traverses this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

It is respectfully submitted that a *prima facie* case of obviousness cannot be established in rejection of amended claims. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when

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combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection".

Claims 1 and 4 now recite that the output control circuit includes the lowpass filter and the highpass arranged in series with one another. In contrast, the Zhang reference merely teaches a low pass filter 40 arranged parallel to the high pass filter 46. Hence, this reference does not suggest the configuration now presented in claims 1 and 4.

Furthermore, with respect to claims 2 and 5, there is no suggestion to provide the cutoff frequencies as claimed. This is especially the case because it is counter intuitive to have a low pass filter with a cutoff frequency lower than a high pass filter which is in series with it since this would dictate at least partial attenuation of all frequencies by filtering action, i.e., action other than insertion loss. However, since the present invention functions by counteracting the phase shift occurring around the relaxation frequency in the optical component section, the attenuation is of secondary consequence to the phase characteristics. It is respectfully submitted that no suggestion of such a design can be found in the references.

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Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejections of claims and their allowance are respectfully requested.

NEW CLAIMS

Claims 11-26 are added and are submitted as patentable over the cited art of record. Independent claim 11 recites subject matter directed to a control circuit which provides "a positive phase shift at said predetermined signal frequency to produce a feedback signal driving said controlling input such that noise attenuation is achieved by feedback control at said predetermined frequency." The predetermined frequency is stated to be the frequency of a -90 degree phase shift in the optical components. The Zhang reference is silent concerning the phase characteristics of the high pass filter 46, and does not address noise concerns in occurring at frequencies whereat a -90 degree shift occurs in the optical device characteristic. This feature, among other features recited therein, is not believed disclosed in the cited art in the manner as claimed.

Claim 18, dependent from claim 11, relates the serial arrangement of the high pass filter and the low pass filter in a feedback circuit. This is submitted as patentable.

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Dependent claims 12-26 are patentable based on the subject matter recited therein in addition to the subject matter of claim 11. For example, claim 12 recites that the feedback circuit has high speed and low speed circuits. The Zhang reference shows feedback circuits having the noted high pass and low pass filters. Since claim 12 relates that the feedback circuit having the phase characteristic introducing the positive phase shift is the high speed circuit, it is noted for the Examiner that the Zhang reference is silent regarding the phase characteristics of the second bias control circuit 32 which includes the high pass filter.

Still further, new claims 14 and 16 recite that a high pass filter and a low pass filter are arranged in series in a high speed feed back circuit. The Zhang reference only shows a high pass filter and a low pass filter, each arranged in a different feedback circuit path. At best, the second bias circuit having the single high pass filter might be considered a high speed feedback circuit. It is clear this circuit does not possess both a high pass filter and a low pass filter arranged in series. Additionally, as regards claims 15, 17 and 19, the Zhang reference certainly fails to suggest the noted cutoff frequency arrangement.

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REQUEST FOR EXTENSION OF TIME

Applicant respectfully requests a two month extension of time for responding to the Office Action. Please charge the fee of \$450.00 for the extension of time to Deposit Account No. 10-1250.

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

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In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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